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EXAMINER

WEAVER, SUE A

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,744

Applicant(s)

PRATT ET AL.

Examiner

Sue A. Weaver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3 and 4 is/are allowed.
- 6) ☒ Claim(s) 5-15 and 17-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the major axis of the resilient biasing member and its tension load and compression load as now claimed in claim 8, and first and second substantially triangular side panel biasing means and side panels made of elastic material, as is claimed in new claim 32, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

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Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

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of the following is required: The resilient biasing member having a major axis such that it bears a tension load and a compression load, as now claimed in claim 8.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 8 and thus 9-14 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It isn't clear how applicants consider the U-shaped biasing member to have a major axis or how it bears a tension load and a compression load along that axis, as claimed in amended claim 8. Applicants only mention potential energy with regard to the biasing member. Furthermore it isn't clear how applicants consider the sides to be triangular shaped as a biasing means or how applicants consider the sides to be elastic as claimed in new claim 32. There doesn't appear to be any mention of elastic sides.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-15 and 17-31, 33, 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-7 each recites the limitation "said biasing member" in the first line. There is insufficient antecedent basis for this limitation in the claim. Applicants appear to have made changes to the independent claims without making corresponding changes to the dependent claims.

Claim 8 recites the limitation "its major axis" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "said bag" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 also recites the limitation "said bag" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "said pocket member" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 17, 19, 20, 21, 22 23 and 24 all recite the limitation "said pocket member" in various lines. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "the pocket" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 28 and 30 recites the limitation "said interior" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim. Furthermore "an opening on line 2 appears to be a double inclusion of that claimed in claim 25.

Claims 33 and 35 each recites the limitation "the bottom" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 34 recites the limitation "the bottom" and "the surface" in lines 3 and 4.

There is insufficient antecedent basis for this limitation in the claim.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15, 17, 18, 21, 24, 25-27, 30, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieber et al and T. Johnson, '971 for the reasons set forth in paragraph 6 of the previous Office action of 3/8/05.

6. Claims 23 and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 15 and 25 above and furthering view of Alter for the reasons set forth in paragraph 7 of the previous Office action.

Claims 15, 17, 18, 21, 24, 25-27, 30 and 31 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Horiuchi in view of Bieber et al, of record.

To have formed the file pocket of Horiuchi in the manner taught by Bieber et al so that it remains closed would have been most obvious to one having ordinary skill in the art. Whether the biasing member lies at the edge of the panel or inward is merely considered to be a matter of degree difference which is not considered to alter the function of the biasing member. Note that the pocket is considered to be on the outer housing as opposed to the inner housing of Horiuchi at 18.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 32 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chi.

Note that the pocket including the gussets of Chi can be made of an elastic material.

8. Claims 33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Soskin.

Note the pocket at 47 of Soskin with a pivot axis at the bottom and a tab at the top forming a user grip.

9. Applicant's arguments, see pages 15-17 of the amendment, filed 6/13/05, with respect to rejections of claims 1, 3, 4 and 26 have been fully considered and are persuasive. The rejections of the claims have been withdrawn.

Applicant's arguments with respect to claims 5-15 and 17-35 have been considered but are moot in view of the new ground(s) of rejection.

With regard to applicant arguments of the rejections of claims 15 and 15 and their dependent claims over the Bieber et al reference, applicants appear to be making up their own rejection and arguing that. It may be noted that in the previous rejections the examiner only relied on T Johnson as a teaching to make Bieber et al of a leather material which is considered to be soft in the manner of bags.

In response to applicant's argument that the structure of Bieber et al and T. Johnson are not combinable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

10. Claims 1, 3 and 4 are allowed while claims 2 and 16 have been canceled.

Claims 5-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pinada, Dorsam and Holtzman show cases with outer housings and inner housings/ Eberle shows another biased closure. Buxton show the use of triangular gussets in a pocket. Guenther et al, Tomikawa et al and Axelman et al show the well known provision of external pockets in brief cases. McCurdy shows a pocket in a bag with a pivot axis above the bottom of the bag.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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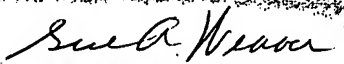
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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Weaver whose telephone number is 571 272-4548. The examiner can normally be reached on Tuesday-Friday.

— The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sue A. Weaver
Primary Examiner